

## REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 4, 5, and 20 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier.

After amending the claims as set forth above, claims 1-23 are now pending in this application.

### 1. Request to Withdraw Finality of Presently Pending Office Action

Prior to addressing the substantive portions of the presently pending Office Action, Applicants respectfully request that the finality of the Office Action be withdrawn. Applicants submit that the finality of the present Office Action is not proper because, with respect to the rejection of claims 4-17 as being indefinite under 35 U.S.C. § 112 ¶ 2, the rejection was “neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement.” See MPEP § 706.07(a).

In a non-final Office Action dated March 31, 2006, the Examiner indicated on page 4 that “[c]laims 4-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.” Applicants amended then-dependent claims 4 and 5 as suggested by the Examiner to be in independent form and to include all of the limitations of the base claim and any intervening claims. No changes to the limitations of any of the amended claims were made, except those necessary to incorporate the additional limitations (as suggested by the Examiner) into presently independent claims 4 and 5, from which claims 6-17 variously depend.

In the present final Office Action, claims 4-17 have now been rejected as being indefinite under 35 U.S.C. § 112 ¶ 2. Applicants submit that this is a new ground of rejection that, as stated above, was neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement. Accordingly, Applicants submit that the finality of the currently pending Office Action is improper and respectfully request that the finality of the present final Office Action be withdrawn.

2. Rejection of Claims 4-17 Under 35 U.S.C. § 112 ¶ 2 as Being Indefinite

On page 2 of the Office Action, the Examiner rejected claims 4-17 under 35 U.S.C. § 112 ¶ 2 as being indefinite for "failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The Examiner stated that "[t]he claims are indefinite in regards to how the top component compression is the result of both service loads and prestressing (claim 4) or post-tensioning (claim 5).

Independent claims 4 and 5 have been similarly amended to remove the phrase "under service loads" to remove any ambiguity as to how the compression is formed according to each of independent claims 4 and 5. Applicants submit that independent claims 4 and 5, as amended, are now in compliance with the definiteness requirement of 35 U.S.C. § 112 ¶ 2, and respectfully request that the rejection of independent claims 4 and 5, and corresponding dependent claims 6-17, be withdrawn.

3. Rejection of Claims 1-3 Under 35 U.S.C. § 102(b) as Being Anticipated by Bettigole et al.

On page 3 of the Office Action, claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bettigole et al. (U.S. Patent No. 5,664,378).

Independent claim 1 has been amended to recite, among other elements, "at least one compression-inducing element within said top component for creating said compression," which is not disclosed by Bettigole et al. Applicants submit that Bettigole et al. does not address compressing concrete or compression-inducing elements. As stated by the Examiner on page 4 of the non-final Office Action dated March 31, 2006, with respect to allowed

independent claim 18, “it is not known nor would it have been obvious to have compression-inducing elements within a top component of a structural element such as the one of the present invention.” Accordingly, Applicants submit that Bettigole et al. does not disclose the subject matter of independent claim 1, and Applicants respectfully request that the rejection of independent claim 1, and corresponding dependent claims 2 and 3, be withdrawn.

3. Rejection of Claim 20 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Bettigole et al.

On page 4 of the Office Action, claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bettigole et al.

Claim 20 has been amended in a similar manner to independent 1, discussed above, to recite, among other limitations, “creating compression with compression-inducing elements within said top component in the direction normal to the bearing bars whereby said compression is maintained under service loads,” which is not taught or suggested by Bettigole et al. As stated by the Examiner on page 4 of the non-final Office Action dated March 31, 2006, with respect to allowed independent claim 18, “it is not known nor would it have been obvious to have compression-inducing elements within a top component of a structural element such as the one of the present invention.” Accordingly, Applicants respectfully request that the rejection of independent claim 20 be withdrawn.

4. Allowable Subject Matter

On page 5 of the Office Action, the Examiner indicated that claims 18 and 19 were allowable. The Examiner further indicated that Claims 21-23 were objected to as being dependent upon a rejected base claim (claim 20), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for the indication of allowance for claims 18 and 19.

Applicants have amended independent claim 20 and believe that independent claim 20 is now in condition for allowance. Accordingly, Applicants respectfully request that the

objection to claims 21-23 as being dependent upon a rejected base claim (claim 20) be withdrawn.

5. Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 10/17/2006

By 

FOLEY & LARDNER LLP  
Customer Number: 26371  
Telephone: (414) 319-7306  
Facsimile: (414) 297-4900

Matthew J. Swietlik  
Attorney for Applicant  
Registration No. 58,428